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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/378,222 08/19/99 PHILYAW

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025883 TM02/1105
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EXAMINER

THOMPSON, M

ART UNIT

PAPER NUMBER

2152

DATE MAILED:

11/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/378,222

Applicant(s)
Philyaw et al.

Examiner
Marc Thompson

Art Unit
2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 5, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-17, 19, and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5,6
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

1. This application has been assigned to a new Examiner. See "Conclusion" section for contact information regarding the new Examiner.
2. Amendment B, received on 8/13/2001, has been entered into record. The change of address received 10/3/2001, is now associated with this application. Claims 1-20 are now pending.

Priority

3. Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-8, 10-17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Palmer et al. (U.S. Patent Number 5,905,865), hereinafter referred to as Palmer, in view of Watanabe (U.S. Patent Number 6,163,803), hereinafter referred to as Watanabe.

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7. Palmer disclosed the invention substantially as claimed. Palmer disclosed the synchronizing of additional, related network retrieved data with digitally stored or received video and audio data. See Column 6, Lines 47-64. This retrieved information was enacted using Internet connection manipulation without human interaction, i.e. automatically. See Column 6, Lines 3-6, and Column 7, Lines 7-12. Palmer disclosed both combination of network locators in the actual video/audio signal, out of band broadcast of locators, and transmission of locators from remote sites. See Column 1, Lines 60-67, Column 2, Lines 25-33, Column 5, Lines 22-43, Column 5, Lines 59-62, and Column 8, Lines 5-19. Palmer also disclosed the use of an "intermediate node" (in the network) which received and redirected URL requests to the appropriate server(s) and compared decisions with the contents of user profiles. See Column 5, Lines 44-62, and Column 7, Lines 28-45.

While Palmer substantially disclosed the embedding of unique resource locators (URLs) (routing information) in a digital stream of network transmitted data (Column 5, Lines 59-62), Palmer remained silent as to the specifics which would have been required to enact this type of functionality. Embedding of network locator (routing information) designations in the streamed data was mentioned as an alternate embodiment to achieve the feature of network resource and remote information synchronizing with stored or delivered digital data.

In the art of network resource encoding, Watanabe disclosed a method and system for encoding network resource locators into stored and delivered digital data for display of remotely stored related information. See Column 4, Lines 28-55. Watanabe also disclosed the

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embedding/encoding of network resource designators specifically with audio signals, and the extraction of the network designators during playback of the audio information. See Column 6, Lines 8-26, and Column 9, Lines 53-56. The URL signal(s) were disclosed as part of the audible signal, resulting in a “tone” and alternatively hidden from listener detection. See Column 6, Lines 59-65, and Column 7, Lines 44-49. The system also automatically retrieved the data according to the specified designator(s). See Column 9, Lines 36-42.

Incorporation of the Watanabe teachings into the teachings of Palmer would have been obvious to one of ordinary skill in the art for the simple reason that recited functionality drawn to the embedding of URL routing information into an audio stream or recording was fully described in such a way to enable the ordinary artisan to implement it. That is, the embedding of URL routing information and overall functionality drawn to delivery of audio/video associated/related information which was remotely stored provided by Palmer in Column 5, Line 59 through Column 6, Line 29, was fully described in detail in Watanabe, Column 4, Lines 28-55. The systems of Palmer and Watanabe were so similar, that practically identical synopsis of the inventions functionality regarding the inclusion of automatically retrieved Internet information to audio/video information were found in Palmer, Column 7, Lines 7-19, and Watanabe, Column 9, Lines 36-42.

Thus, since the teachings contain direct suggestion for combination, an individual one of the teachings would have resulted in an ordinary artisan being motivated to “fill in the blanks” (by searching for further teachings), and the inventions being drawn to the same concept of

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associated Internet information delivery related with audio/video digitally stored/transmitted information, combination of the teachings would have been obvious to one of ordinary skill in the art at the time the invention was made.

Since, all limitations recited in claims 1-8, 10-17, and 19-20, were disclosed by the combination of Palmer and Watanabe, claims 1-8, 10-17, and 19-20 are rejected.

Allowable Subject Matter

8. Claims 9 and 18 are allowed. The detail of the system component interaction in the recited functionality is sufficient to distinguish over the prior art of record.

Response to Arguments

9. Applicant's arguments filed with Amendment B, have been fully considered but they are not persuasive.

a. Applicant asserts distinguishing the present invention through the automation of information retrieval (i.e., without human intervention/activation). The most compelling argument to the lack of novelty/inventive step concerning this feature is found in MPEP §2144(II) and §2144(III). If all the information is located at the client device for enactment, and simply waits for user input, it would have been routine to automate the function(s) in order to maximize efficiency by minimizing unnecessary user interaction. Lastly, it is clear from Palmer et al. (U.S. Patent Number 5,905,865) that both methods for enacting remote information retrieval were equally viable. See Column 6, Lines 39-46.

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b. Applicant's arguments found on Page 6, Lines 4-11, of the response, Paper #12, Amendment B, leads the Examiner to believe that the crux of the invention lies in "within the audio program is embedded a unique code...automatically link[ing] the user node to the destination node". This broadly described functionality was clearly anticipated and expressly taught by Watanabe. See Abstract, and Figure 4. In order to clarify the point(s) of novelty of the invention as claimed, the Examiner suggests incorporation of remote transmission/decision making of information deployment including user node identification and an associated user node/user identification profile, with thorough description of transmission information sets and inter-system process/component interaction(s), resulting in determined decisions and information/information addressing for delivery of associated information to a client device.

10. Additionally, Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

11. Information disclosure statements (IDSs) (Paper#5 and Paper #6) are being resupplied to Applicant, after removal of duplicate references submitted on both IDSs. The references listed on Paper #6, which were previously listed on Paper #5, have been removed from the IDS itself to eliminate the possibility of duplicate printing should the application pass to issue.

12. It should be noted that the applicant has submitted an exorbitant amount of prior art on numerous PTO-1449's which on initial consideration appears to not all have relevancy or

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pertinence to the instant invention as claimed. The applicant is requested in response to this office action to point out which of these numerous prior art are pertinent or relevant to the patentability of the invention as claimed in this instant application. It should be noted that it would be advantageous to the applicant to provide a concise explanation of why each of the prior art is being submitted and how it is understood to be relevant. "Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability." (See MPEP 609 under subheading "A. CONTENT").

13. One of the most relevant documents disclosed in the IDSs is Hidary et al. (U.S. Patent Number 5,774,664), hereinafter referred to as Hidary. As the invention in the present application is broadly claimed, it is difficult for the Examiner to ascertain any distinguishing features of the current claimed invention with regard to the disclosure of Hidary. Applicant is encouraged to specifically address differences between the Hidary reference and the presently claimed invention to eliminate use of this reference in any future rejections.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Philyaw et al. (U.S. Patent Number 6,098,106) is the document to which the current application claims priority under 35 U.S.C. § 120.

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15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750. The Examiner can normally be reached on Monday-Friday from 9am to 4pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark Rinehart, can be reached at (703) 305-4815.

The fax phone numbers for the organization where this application is assigned are as follows:

(703) 746-7238	(After Final Communications only)
(703) 746-7239	(Official Communications)
(703) 746-7240	(for Official Status Inquiries, Draft Communications only)

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Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900.

MDT
Marc D. Thompson
Patent Examiner
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MARK H. RINEHART
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100